

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

Claims 4-16 are now present in this application. Claims 4 and 10 are independent. Claims 6-12 stand withdrawn from consideration as being directed to non-elected subject matter.

Claims 1-3 were previously canceled. Claims 4, 5, 13 and 15 have been amended herein to delete the possibility that R1 is a substituted or unsubstituted acyl group. Also, claim 1 has been amended to give a definition for R4 in subgenus "(1)".

No new matter has been added. Reconsideration of this application, as amended, is respectfully requested.

Claim Objection

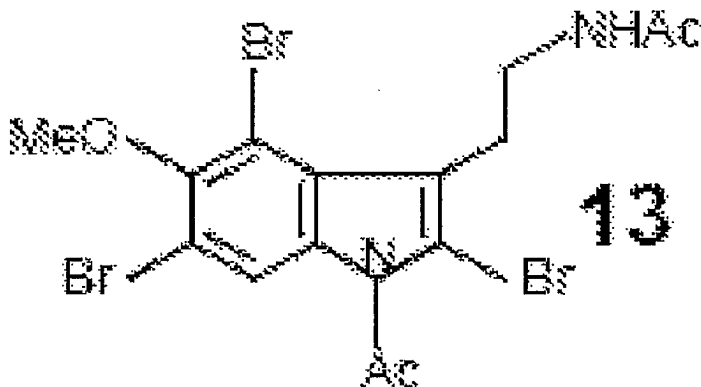
Claim 13 is objected under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner describes that "[I]t appears that claim 1 does not recite a halogen but rather recites a bromine (which is a type of halogen) whereas claim 13 broadly requires a halogen."

It appears that the Examiner meant to refer to claim 4 and has misread claims 4 and 13. Claim 13 recites: "The compound represented by formula (I') according to claim 4, wherein R³ and R⁵ each represents a halogen atom." Whereas claim 4 recites: "R³, R⁵ and R⁶ are the same or different and each represents a hydrogen atom or a halogen atom...". As such, Claim 13 further limits claim 4. Withdrawal of the objection is respectfully requested.

Claim Rejections - 35 USC § 102

Claims 4-5 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Somei et al. (Heterocycles, Vol. 53, No. 8, pages 1725-1736, 2000). Applicants respectfully traverse the rejection.

The Examiner asserts that Somei et al. teaches the Compound **13**:



In response Applicants have amended claim 4 by deleting the option that R1 can be a "substituted or unsubstituted acyl".

Accordingly, the amended claims are not anticipated by Somei et al. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim Rejections - 35 USC § 103

Claims 4-5 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Somei et al. (Heterocycles, Vol. 53, No. 8, pages 1725-1736, 2000).

As mentioned above, the Examiner asserts that Somei et al. teaches the Compound **13**. In response Applicants have amended claim 4 by deleting the option that R1 can be a "substituted or unsubstituted acyl".

Applicants respectfully submit that the skilled artisan would not find the compounds remaining in amended claim 4 obvious over Somei et al.

The Examiner's attention is directed to MPEP 2144.08 regarding the species/genus analysis for obviousness. At MPEP 2144.08.II.A.4(c), the following guidance is provided, "[c]onsider any teachings of a "typical," "preferred," or "optimum" species or subgenus *within the disclosed genus*. If such a species or subgenus is structurally similar to that claimed, its

disclosure may *>provide a reason for< one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species *usually have similar properties*.” (Emphasis added).

Here, Applicants respectfully submit that the skilled artisan would not find that the compounds, as presently claimed, have similar properties to Compound **13** of Somei et al.

Somei et al. describes as follows:

Structures of **8-11** except for **12** were determined by spectral data. As for **12**, however, 2,4,7-tribromomelatonin is an alternative possible candidate. Therefore, **12** was further converted to 1-acetyl derivative (**13**) in 53% yield by treatment with NaH, followed by the reaction with AcCl. Comparison of the ¹H-NMR spectrum of **12** with that of **13** clearly showed the anisotropy effect of 1-acetyl group on the singlet C(7)-proton by *ca.* 1 ppm, proving that **12** and **13** are 7-unsubstituted indoles. (See page 1726, bottom line to page 1727, line 4)

Therefore, Somei et al. merely discloses that Compound **13** was produced in order to determine the structure of Compound **12**, and does not teach any specific or significant utility for Compound **13**. As MPEP 2144.09 (VI) states, “IF PRIOR ART COMPOUNDS HAVE NO UTILITY, OR UTILITY ONLY AS INTERMEDIATES, CLAIMED STRUCTURALLY SIMILAR COMPOUNDS MAY NOT BE PRIMA FACIE OBVIOUS OVER THE PRIOR ART.”

Further, the instantly claimed compound functions to activate osteoblasts and suppress osteoclasts. Such a compound is useful for a pharmaceutical composition for various bone-related diseases, such as a pharmaceutical composition for preventing or treating osteoporosis, or as an osteoblast activator and an osteoclast suppressor, in various fields, such as regenerative medicine, dentistry, or production of edible meats or eggs via fish cultivation or healthy development of livestock. (See page 9, line 24 to page 10, line 2, and Examples 15 of the specification)

Somei et al. neither teach nor suggest the above effects of the instantly claimed compound.

Accordingly, a *prima facie* case of obviousness cannot be said to exist based on the teachings of Somei et al, and claims 4, 5 and 13-16 are patentable over Somei et al. Reconsideration and withdrawal of the rejection are respectfully requested.

Request for Rejoinder

As described above, claim 4 is allowable. Claims 6-9 depend from or require all the limitations of the allowable claim 4. Therefore, claims 6-9 should be fully examined for patentability in view of *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and MPEP 821.04(b).

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

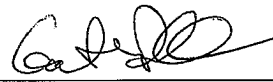
In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Registration No. 48501 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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